

REMARKS

Claims 1-12 have been examined on their merits, and are all the claims presently pending in the application.

1. Claims 1, 2, 11 and 12 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Neilsen (U.S. Patent No. 5,870,548). Applicants traverse the § 102(e) rejection of claims 1, 2, 11 and 12 for at least the reasons discussed below.

With respect to amended claim 1, Neilsen fails to teach or suggest at least that modification of the e-mail message body is blocked for all addressees if at least one addressee of a plurality of addressees has viewed the e-mail message body. In the Response to Arguments section, the Patent Office states that Neilsen discloses that the modification of the e-mail body is denied if at least one addressee has accessed the e-mail body. However, Nielsen does not specifically prohibit the modification of the e-mail message body for all addressees if at least one addressee has viewed the e-mail message body. The Patent Office cites col. 14, line 65 to col. 15, line 15 as allegedly disclosing the subject matter in claim 1. The cited text follows:

If the previously-sent message has been seen by the recipient 1011 (as described below for FIG. 11A), the receiving e-mail system informs the recipient that the message was canceled 1013. The recipient is given a number of choices as what to do with the previously-sent message 1015. These options include but are not limited to deleting the original message or treating the cancel message as a normal message. If the recipient decides to delete the original message, the recipient's e-mail program uses the location field 803 in the message database record 800 to find and delete the message and to clear the location field 803. Further, the message seen field 823 of the associated cancel record 820 is set to TRUE. Next 1022 the recipient's e-mail system returns a confirmation message to the sender of the previously-sent and cancel messages indicating that the message has been

canceled but that the recipient has seen the canceled message prior to cancellation. Finally, the process completes through the terminal labeled as 1009.

Nothing in the above-cited passage from Neilsen teaches or suggests preventing the modification of an e-mail body sent to multiple addressees if one addressee has viewed the message. The cited portion of Neilsen is directed to a single addressee, not to multiple addressees as recited in claim 1. Furthermore, the Patent Office claims that Neilsen discloses a server that operates independently from any e-mail processing means associated with each of the recipients, and the Patent Office states that Applicants' claimed server is the sender's email system (200) shown in Figure 2 of Neilsen. However, Neilsen is clear that no modification occurs on the sender's system. Neilsen states at col. 11, lines 16-26:

The previous discussion has disclosed the invention as it relates to the *sending e-mail system*. Action messages constructed according to the above described invention can be sent to a prior art e-mail system. In this case, the X-Cancel:, the X-Modify:, and the modified Subject: fields are all displayed to the recipient. This informs the recipient of the sender's intent, but goes no further and *does not delete or modify the selected previously-sent message 659*. Thus, while the invention as disclosed above is useful, it is further enhanced by *modifying the receiving e-mail system to specially process the modify and cancel messages*.

Neilsen is clear that the sending e-mail system does not modify the e-mail body, and that the receiving e-mail system associated with the addressee performs the modification and/or cancellation of e-mail message bodies. However, claim 1 of the present invention recites that the server operates independently from any e-mail processing means associated with each of the addressees of a particular e-mail body. Contrary to the Patent Office's statement, Neilsen does associate an e-mail processing means (i.e., the receiving e-mail system) with an addressee (i.e., message recipient).

Based on at least the foregoing reasons, Applicants submit that claim 1 is allowable, and further submit that claim 2 is allowable as well, at least by virtue of its dependency from claim 1. Applicants respectfully request that the Patent Office reconsider and withdraw the § 102(e) rejection of claims 1 and 2.

With respect to amended independent claims 11 and 12, Applicants submit that claims 11 and 12 are allowable for at least reasons analogous to those discussed above with respect to claim 1. Applicants submit that claims 11 and 12 is allowable, and respectfully request that the Patent Office reconsider and withdraw the § 102(e) rejection of claims 11 and 12.

2. Claims 3-10 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Neilsen in view of Uchida *et al.* (U.S. Patent No. 6,327,610). Applicants traverse the § 103(a) rejection of claims 3-10 for at least the reasons discussed below.

The Patent Office acknowledges that Neilsen fails to teach or suggest the use of an access code for accessing an e-mail body. The Patent Office alleges that Uchida *et al.* contains the necessary disclosure to overcome the acknowledged deficiencies of Neilsen.

With respect to amended independent claim 3, the combination of Neilsen and Uchida *et al.* fails to teach or suggest that modification of the e-mail message body is blocked for all addressees if at least one addressee of a plurality of addressees has viewed the e-mail message body. As noted above with respect to claim 1, Nielsen fails to teach or suggest several features of the invention as recited in independent claim 3, namely the preventing the modification of e-mail bodies addressed to a plurality of addressees if one addressee has viewed the e-mail body

and a server operating independently from any e-mail processing means associated with each of the addressees of a particular e-mail body. The combination of Neilsen with Uchida *et al.* fails to overcome at least these noted deficiencies of Neilsen. Thus, Applicants submit that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness.

Applicants submit that one of skill in the art would not be motivated to combine Neilsen with Uchida *et al.* Both Neilsen and Uchida *et al.* lack any teaching about at least the desirability of prohibiting the modification of the e-mail message body for all addressees if at least one addressee has viewed the e-mail message body, and the association of a server storing the e-mail body with addressees of the e-mail body. Applicants submit that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness.


Based on the foregoing reasons, Applicants submit that claim 3 is allowable, and further submit that claims 4-10 are allowable as well, at least by virtue of their dependency from claim 3. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claims 3-10.

AMENDMENT UNDER 37 C.F.R. § 1.111
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ATTORNEY DOCKET NO. Q60742

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Paul J. Wilson
Registration No. 45,879

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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